



UNITED STATES DEPARTMENT OF COMMERCE  
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/640,020	08/10/84	BRANDSTROM	25901-4

BRUMBAUGH, GRAVES, DONOHUE AND RAYMOND  
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NEW YORK, NY 10112

EXAMINER	
FAN, J	
ART UNIT	PAPER NUMBER
121	7

DATE MAILED: 01/02/85

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice re Patent Drawing, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449
- ☐ Notice of informal Patent Application, Form PTO-152
- ☐ Information on How to Effect Drawing Changes, PTO-1474
- ☐ \_\_\_\_\_

Part II SUMMARY OF ACTION

- ☒ Claims 1-7, 16-31 are pending in the application.  
Of the above, claims 5-7 are withdrawn from consideration.
- ☐ Claims \_\_\_\_\_ have been cancelled.
- ☐ Claims \_\_\_\_\_ are allowed.
- ☒ Claims 1-4, 16-31 are rejected.
- ☐ Claims \_\_\_\_\_ are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
- ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
- ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
- ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-4, 16-31, drawn to omeprazole salts and their compositions and method of use, classified in Class 424, subclass 263, class 546, subclass 271.

II. Claims 5-7, drawn to a process for the preparation of the compounds of group I, classified in Class 546, subclass 271.

The inventions are separate and distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). In the instant case the products can be made by other methods. Note pat. 447209.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter restriction for examination purposes as indicated is proper.

During a telephone conversation with Ms. Ryan on December 18, 1984 a provisional election was made with traverse to prosecute the invention of group I, claims

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1-4, 16-31. Affirmation of this election must be made by applicant in responding to this Office action.

Claims 5-7 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 16-31 are rejected under 35 U.S.C. 103 as being unpatentable over Seen-Bilfinger, Ep. 5129, Ep 45200. Elderfied all considered together.

Ep 5129 (ex. 23), Ep 45200 (p. 8. line 23) all disclose omeprazole. Elderfied and Senn-Bilfinger (col. 2. lines 47-53 and col. 11. example 18) generically and specifically disclose the basic salt of structurally closely related compounds rendering the claimed compounds obvious.

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Claims 16-19 are rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite and beyond the enabling disclosure since they fail to recite 1) an intended use 2) an effective amount of the active ingredient 3) a pharmaceutical carrier.

Applicant's presentation of prior art statement and accompanying references is noted with appreciation. The references have been placed of record in the file.

Fan:st

A/C 703

557-3820

12-28-84

*Jane T. Fan*  
JANE T. FAN  
PRIMARY EXAMINER  
ART UNIT 121